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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,626	09/20/2000	Dieter Bauerfeind	10677/31	5098

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ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

BECKER, SHAWN M

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/646,626

Applicant(s)

BAUERFEIND, DIETER

Examiner

Shawn M. Becker

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

It is suggested to replace "by means of" in the sixth line of the abstract with --through the use of--.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 10-18 are directed toward a controller, but the use of the controller is unclear in the original disclosure. There is no mention of what it controls or what it is used for. The switching function is also ambiguous. The specification is not clear with respect to what is being switched. In addition, the example of the switching function for roller blinds is not descriptive.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 10-18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,040,829 to Croy et al.

Referring to claim 10, Croy shows in Fig. 3B, a programmable controller (200) with a processing unit (microcontroller; Fig. 1, 130), a display screen (Fig. 3B, 240) including a menu-assisted user interface, an operator unit including a button (softkeys; 310 and 311). The buttons are capable of being switched to an active mode using a programmable function. For example, some buttons may be active during TV mode, but are inactive during VCR mode. Fig. 3B, shows several other buttons that create a signal input when pressed, and there is a signal output to the TV or device being controlled. Fig. 3B shows that the processing unit, display screen, operator unit, signal input and signal output are disposed in a housing. See col. 2, lines 15-30.

A switching function of the controller is programmable in a programmed sequence according to predetermined functions using the menu-assisted user interface, and an operation of the button is capable of affecting a switching sequence of the switching function when the button is in active mode. See col. 3, lines 5-15, which describe how the user interface can be used to choose among (switch to) different functions for the controller. Also, see col. 10, line 53 – col. 11, line 21.

Croy shows another example of a switching function for programming a softkey to perform a sequence of user interactions in col. 18, line 49 – col. 19, line 10.

Referring to claim 11, an operation of the button in Croy can simulate the at least one signal input when the button is in active mode. See col. 7, lines 30-39, which describes the softkeys.

Referring to claim 12, Croy shows the programmed sequence of the switching function is interrupted when the button is operated in the active mode. See col. 7, lines 58-68.

Referring to claim 13, the switching function of Croy can be interrupted by operation of the button in the active mode. See col. 7, lines 58-68.

Referring to claim 14, the operation of the button of Croy is performable at any point of the programmable switching function. See col. 7, lines 58-68, which shows the “Back” and “Menu” buttons can be used at any time.

Referring to claims 15-16, the controller of Croy has a second button capable of affecting the switching function and capable of being switched to an active mode. See Fig. 3B; softkeys 310 and 311.

Referring to claim 17, the display of Croy is capable of displaying an instruction to operate the active button. See Fig. 3B, 240 and Col. 7, lines 40-45.

Referring to claim 18, the display of Croy is capable of displaying an instruction to operate the active button. See Fig. 3B, 240 and Col. 7, lines 40-45. The instruction to operate the active button may be accompanied by an acoustic signal. See. Col. 7, line 36, which describes how voice input may be used.

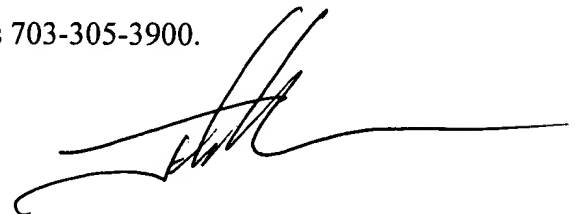
### ***Conclusion***

6. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach other controllers with switching functions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Becker whose telephone number is 703-305-7756. The examiner can normally be reached on M-T 8:00 - 5:30 and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 703-305-3116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-745-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

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January 27, 2003